

LKM

THIS DISPOSITION IS NOT CITABLE AS
PRECEDENT OF THE TTAB MAY 25, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sportacular, Inc.

v.

Kukje Corporation

Cancellation No. 26,334

Sportacular, Inc., pro se.

Francie R. Gorowitz of Ladas & Parry, for Kukje Corporation.

Before Simms, Rogers and McLeod, Administrative Trademark Judges.

Opinion by McLeod, Administrative Trademark Judge:

Sportacular, Inc. ("petitioner") has petitioned to cancel the registration owned by Kukje Corporation ("respondent") for the mark PRO-SPECS for "athletic shoes."¹

As grounds for cancellation, petitioner alleges that it has filed an application for registration of the mark PRO SPEX USA

¹ Registration No. 1,426,635, issued January 27, 1987. Sections 8 & 15 affidavits filed.

and design for "clip-on sunglasses assembly for hats, visors and headgear," which has been refused registration based upon the above registration. (Pet. to Cancel ¶¶ 1-3). Petitioner claims that respondent discontinued use of the registered mark for a period over two years with intent not to resume use. (Pet. to Cancel ¶¶ 6-9).² Petitioner also asserts that respondent is no longer in business and is no longer using the mark. (Pet to Cancel ¶ 6).

Respondent, in its answer, admits that its predecessor, Kukje America Corporation, once had a business address in New Jersey, but respondent is currently located in Korea. Respondent has denied the other essential allegations of the petition to cancel.

Petitioner's abandonment theory focuses on respondent's predecessor-in-interest, Kukje America Corporation. Petitioner argues that when the involved registration was assigned from the original registrant, Pro-Specs International, Inc., to Kukje America Corporation, the mark was abandoned. Petitioner concludes that Kukje America Corporation ceased doing business in the United States because it did not file an annual report with the state of New Jersey in 1984, and lost its corporate license in 1994. Petitioner concludes, therefore, that Kukje America

² As of January 1, 1996, the Trademark Act was amended to require a claim of three years nonuse, rather than two years, as a prima facie case for abandonment. See Trademark Act Section 45, 15 U.S.C. Section 1127. Since the petition to cancel was filed after this date on May

Corporation obtained a "naked" assignment from Pro-Specs International, Inc. Petitioner also argues that neither Kukje America Corporation nor Kukje Corporation provided any evidence of use or ownership of the mark during respondent's testimony period.

Respondent, on the other hand, contends that petitioner failed to prove a prima facie case of abandonment. According to respondent, petitioner's brief consists of unsupported allegations which have no evidentiary value. Respondent objects to much of petitioner's evidence. Respondent also argues that petitioner's assertions concerning Kukje America Corporation are irrelevant because the involved registration was assigned to respondent in 1993. In any event, respondent argues, Kukje America Corporation filed affidavits under Sections 8 and 15 of the Trademark Act, 15 U.S.C. Sections 1058 and 1065, attesting to continuous use of the mark for a period of five years prior to the filing of the affidavits. Furthermore, respondent maintains that it provided model numbers and sales figures for the years 1994 and 1997 in response to petitioner's discovery requests, which were made of record by petitioner.

The record consists of the pleadings; the registration file; respondent's answers to petitioner's interrogatories introduced by notice of reliance (Petitioner's "Notice of Reliance I"); and copies of public records from the State of New Jersey submitted

17, 1997, petitioner must establish three years of nonuse for a prima

under notice of reliance (Petitioner's "Notice of Reliance II"). The parties also submitted briefs. An oral hearing was not requested.

As an initial matter, respondent's objection to petitioner's "Notice of Reliance II" is sustained. As noted by respondent, the public records submitted under petitioner's notice of reliance are not properly authenticated in accordance with the rules of evidence. See TBMP Section 707. Specifically, petitioner failed to submit a "certified" copy of the public records prepared by the custodian or other authorized person. See Trademark Rule 2.122 and Fed. R. Evid. 901(b)(7) and 902(4). Accordingly, this evidence has been given no consideration.³

Turning to the merits of the petition for cancellation, a party claiming abandonment has the burden of establishing the case by a preponderance of the evidence. Introduction of evidence of nonuse of the mark for three consecutive years constitutes a prima facie showing of abandonment and shifts the burden to the party contesting the abandonment to: (1) provide

facie case of abandonment.

³ Even if we considered this evidence, we would reach the same result in this case. The mere fact that respondent's predecessor, Kukje America Corporation, did not file an annual report in 1984, or that its corporate license was revoked in 1994 does not establish a period of three consecutive years of nonuse, which would constitute a prima facie case of abandonment. In fact, these dates are of little importance in this case because the involved registration issued in the name of Pro-Specs International, Inc. in 1987, and was not assigned to Kukje America Corporation until 1988. Kukje America Corporation, in turn, assigned the registration to Kukje Corporation in 1993 (Assignment Reel 1091 and Frame 0242). In short, Kukje America Corporation was not the record owner of the involved registration in either 1984 or 1994.

evidence to disprove the underlying fact triggering the presumption of abandonment; and/or (2) provide evidence of an intent to resume use to disprove the presumed fact of no intent to resume use. *Id.* at 1312. See Trademark Act Section 45, 15 U.S.C. Section 1127;⁴ *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 U.S.P.Q.2d 1390 (Fed. Cir. 1990); *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 U.S.P.Q.2d 1307, 1309 (Fed. Cir. 1989).

After careful review of the parties' arguments and the evidence of record, the Board finds that petitioner has failed to prove abandonment. None of the evidence presented by petitioner establishes three consecutive years of nonuse of the mark, which would constitute a prima facie case, nor does it otherwise demonstrate that respondent, or its predecessors-in-interest, discontinued use of the PRO-SPECS mark with an intent not to resume use. The evidence of record establishes, at most, that Kukje America Corporation did not have a warehouse or large staff in the United States, and that Kukje Corporation has limited knowledge of its predecessors' business operations. However, these factors do not demonstrate discontinued use of the mark for any period of time.⁵ We simply cannot conclude, on

⁴ See *supra* note 2.

⁵ Petitioner, in its reply brief, maintains that neither Kukje Corporation nor its predecessors presented any evidence during respondent's testimony period. There are several problems with petitioner's contention. First, respondent's predecessors are not involved in this proceeding. The cancellation proceeding was properly

this record, that respondent or its predecessors discontinued use of the mark with intent not to resume use.

DECISION:

Accordingly, the petition to cancel is hereby dismissed with prejudice.

R. L. Simms

G. F. Rogers

L. K. McLeod
Administrative Trademark
Judges, Trademark
Trial and Appeal Board

instituted by the Board against Kukje Corporation, record owner of the involved registration prior to the commencement of this case. See 37 CFR Section 2.113, and *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 U.S.P.Q. 109 (T.T.A.B. 1976); TBMP Sections 120.01, 315 and 512. Second, as noted above, the initial burden of proving abandonment rests with petitioner, but petitioner has failed to carry that burden. As a result, the burden of proof does not shift to respondent. See *Cerveceria, supra*; *P.A.B. Produits et Appareils de Beaute v. Santinine Societa*, 670 F.2d 1031, 196 U.S.P.Q. 801 (C.C.P.A. 1978).